

## **REMARKS**

By this Amendment Applicant has amended claim 16 to adjust the dependency of claim 16 from independent claim 11. Claims 1-35 remain pending in this case.

In the Office Action dated January 22, 2004, the Examiner rejected claim 16 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 1-2, 5, 8, 10-11, 16-17, 21-22, 25, 28-29, 32, and 35 under 35 U.S.C. § 102(e) as being anticipated by Angles et al. (U.S. Patent No. 5,933,811); rejected claims 3-4, 7, 9, 12-14, 18-19, 23-24, 26-27, 30-31, and 33-34 under 35 U.S.C. § 103(a) as being unpatentable over Angles et al.; and rejected claims 6, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Angles et al. in view of Bezos et al. (U.S. Patent No. 6,029,141).

### **I. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph**

The rejections of claims 18, 21, 22, and 23 under 35 U.S.C. § 112, second paragraph, have been overcome for the following reasons.

The Examiner alleged that claim 16 was confusing because it claims a system but was depending from a method claim. By this Amendment, Applicant has amended claim 16 to depend upon claim 11, which is directed to a system, rather than claim 10, which recites a method. As further amended, claim 16 further defines the central processing unit of claim 11. In view of this amendment, Applicant requests that the rejection of claim 16 under 35 U.S.C. § 112, second paragraph, be withdrawn and the claim allowed.

## II. Claim Rejections Under 35 U.S.C. § 102(e)

The rejection of claims 1-2, 5, 8, 10-11, 16-17, 21-22, 25, 28-29, 32, and 35 under 35 U.S.C. § 102(e) is respectfully traversed for the following reasons.

In order to anticipate Applicant's claimed invention under 35 U.S.C. § 102(e), "each and every element as set forth in the claim [must be] found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131, at 2100-70 (8th ed., rev. Feb. 2003) (quoting Verdegaal Bros. v. Union Oil Co. of Cal., 814 F.2d 628, 631 (Fed. Cir. 1987)). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. § 2131, at 2100-70 (quoting Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989)). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131, at 2100-70.

In rejecting claims 1-2, 5, 8, 10-11, 16-17, 21-22, 25, 28-29, 32, and 35 under 35 U.S.C. § 102(e) the Examiner alleges that Angles et al. anticipates these claims. Applicant respectfully disagrees.

### **A. The Rejection of Claims 1-2, 5, 8, and 10.**

Claim 1 recites a combination including, *inter alia*, "registering a wireless device" and "receiving registration information including at least a wireless device number." Contrary to the Examiner's allegation, Angles et al. does not teach at least "registering a wireless device" nor "receiving registration information including at least a wireless device number," as recited in claim 1.

Applicant's claim 1 recites a method of "registering a *wireless device* to receive advertising messages" (emphasis added). In contrast, Angles et al. teaches a system of registering *consumers* that allows consumers to receive customized advertising as

they surf the Internet. See Angles et al., col. 3, lines 6-29. The consumer registers by entering demographic data and is assigned a member code by the registration system. See Angles et al., col. 14, lines 16-32. The registration system disclosed in Angles et al. does not involve the registration of any devices, let alone wireless devices, as recited in Applicant's claim 1. Accordingly, Applicant's claim 1 recites "registering a wireless device." Angles et al., however, merely teaches registering a consumer.

Furthermore, Angles et al. does not teach at least "receiving registration information including at least a wireless device number," as recited in claim 1. The registration system disclosed in Angles et al. involves the entry of consumer demographic information including "age, sex, income, career, interests, hobbies, consumer preferences, the account number of the consumer's Internet provider, other account information, etc." Angles et al., col. 14, lines 16-26. Contrary to the present claimed invention, however, Angles et al. never even mentions a wireless device number as being part of the registration information. Accordingly, Angles et al. fails to teach at least "registering a wireless device" and "receiving registration information including at least a wireless device number," as recited in claim 1.

For at least the foregoing reasons, claim 1 is not anticipated by Angles et al. Accordingly, Applicant requests that the rejection of claim 1 under 35 U.S.C. § 102(e) be withdrawn and the claim allowed.

Claims 2, 5, 8, and 10 depend upon claim 1. As explained above, claim 1 is patentable over Angles et al. Accordingly, claims 2, 5, 8, and 10 are also patentable at least because of their dependency from allowable claim 1. Applicant therefore

requests that the rejection of claims 2, 5, 8, and 10 be withdrawn and the claims allowed.

**B. The Rejection of Claims 11 and 16.**

Claim 11 recites a combination including, *inter alia*, “a database comprising wireless device numbers for storing users of registered wireless devices.” As pointed out above with respect to claim 1, Angles et al. does not teach at least the registration of wireless devices or the receipt of registration information including wireless device numbers. Angles et al. does mention the storage of consumer demographic data in a database. Angles et al., col. 17, lines 18-20. As previously discussed, however, the demographic data disclosed in Angles et al. does not include wireless device numbers. Therefore, the database disclosed in Angles et al. does not contain wireless device numbers. Accordingly, Angles et al. fails to teach at least “a database comprising *wireless device numbers* for storing users of *registered wireless devices*,” as recited in claim 11 (emphasis added).

For at least the foregoing reasons, claim 11 is not anticipated by Angles et al. Accordingly, Applicant requests that the rejection of claim 11 under 35 U.S.C. § 102(e) be withdrawn and the claim allowed.

As amended, claim 16 depends upon claim 11. As explained above, claim 11 is patentable over Angles et al. Accordingly, claim 16 is patentable at least for its dependency from allowable claim 11. Applicant therefore requests that the rejection of claim 16 be withdrawn and the claim allowed.

**C. The Rejection of Claims 17 and 21.**

Claim 17 recites a combination including, *inter alia*, “providing a database containing a plurality of users of registered wireless devices and associated wireless device numbers.” As pointed out above with respect to claims 1 and 11, Angles et al. does not teach the registration of wireless devices or a database containing wireless device numbers. Accordingly, Angles et al. fails to teach at least “providing a database containing a plurality of users of *registered wireless devices* and associated *wireless device numbers*,” as recited in claim 17 (emphasis added). For at least the foregoing reasons, claim 17 is patentable over Angles et al. Accordingly, Applicant requests that the rejection of claim 17 under 35 U.S.C. § 102(e) be withdrawn and the claim allowed.

Claim 21 depends upon claim 17. As explained above, claim 17 is patentable over Angles et al. Accordingly, claim 21 is patentable at least because of its dependency from allowable claim 17. Applicant therefore requests that the rejection of claim 21 be withdrawn and the claim allowed.

**D. The Rejection of Claims 22, 25, and 28.**

Claim 22 recites a combination including, *inter alia*, “providing advertising messages to a wireless advertising service that sends the messages to a plurality of wireless devices registered with the service.” As explained above with respect to claim 1, Angles et al. does not teach the registration of wireless devices. Accordingly, Angles et al. fails to teach at least “providing advertising messages to a wireless advertising service that sends the messages to a plurality of *wireless devices registered with the service*,” as recited in claim 22 (emphasis added). For at least the foregoing

reasons, claim 22 is patentable over Angles et al. Accordingly, Applicant requests that the rejection of claim 22 under 35 U.S.C. § 102(e) be withdrawn and the claim allowed.

Claims 25 and 28 each depend upon claim 22. As explained above, claim 22 is patentable over Angles et al. Accordingly, claims 25 and 28 are patentable at least because of their dependency from allowable claim 22. Applicant therefore requests that the rejection of claims 25 and 28 be withdrawn and the claims allowed.

**E. The Rejection of Claims 29, 32, and 35.**

Claim 29 recites a combination including, *inter alia*, “sending advertising messages to a registered wireless device.” As explained above with respect to claim 1, Angles et al. does not teach the registration of wireless devices. Accordingly, Angles et al. fails to teach at least “sending advertising messages to a *registered wireless device*,” as recited in claim 29 (emphasis added). For at least the foregoing reasons, claim 29 is patentable over Angles et al. Accordingly, Applicant requests that the rejection of claim 29 under 35 U.S.C. § 102(e) be withdrawn and the claim allowed.

Claims 32 and 35 depends upon claim 29. As explained above, claim 29 is patentable over Angles et al. Accordingly, claims 32 and 35 are patentable at least by reason of their dependency from allowable claim 29. Applicant therefore requests that the rejection of claims 32 and 35 be withdrawn and the claims allowed.

### III. Claim Rejections Under 35 U.S.C. § 103(a)

The rejection of claims 3-4, 6-7, 9, 12-15, 18-20, 23-24, 26-27, 30-31, and 33-34 under 35 U.S.C. § 103(a) is respectfully traversed for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” M.P.E.P. § 2143.

#### **A. The Rejection of Claims 3-4, 7, 9, 12-14, 18-19, 23-24, 26-27, 30-31, and 33-34.**

Claims 3-4, 7, and 9; 12-14; 18-19; 23-24 and 26-27; and 30-31 and 33-34 depend upon claims 1, 11, 17, 22, and 29, respectively. As explained above, claims 1, 11, 17, 22, and 29 are patentable over Angles et al. in that Angles et al. does not teach at least “registering a wireless device,” “receiving registration information including at least a wireless device number,” or “a database comprising wireless device numbers.” Furthermore, Angles et al. does not suggest at least “registering a wireless device,” “receiving registration information including at least a wireless device number,” or “a database comprising wireless device numbers.” Accordingly, claims 3-4, 7, 9, 12-14, 18-19, 23-24, 26-27, 30-31, and 33-34 are patentable over Angles et al. because the reference fails to teach or suggest at least “registering a wireless device,” “receiving registration information including at least a wireless device number,” or “a database

comprising wireless device numbers,” as recited in independent claims 1, 11, 17, 22, and 29. Moreover, claims 3-4, 7, 9, 12-14, 18-19, 23-24, 26-27, 30-31, and 33-34 are further distinguishable from Angles et al. for their own unique features.

Regarding claims 3-4, 19, 24, and 31, the Examiner admitted that Angles et al. does not teach that incentives include points or additional air time, but alleges that:

[T]hese differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The “registering” through “remunerating” steps would be performed the same regardless of the type of incentives. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability[.]

Office Action at 4. Similarly, regarding claims 23, 26, 30, and 33, the Examiner admitted that Angles et al. does not teach that advertising messages are text messages or coupons, but again alleged the presence of “nonfunctional descriptive material . . . not functionally involved in the steps recited [in the claims].” Office Action at 6.

Applicant disagrees with the Examiner’s characterizations of the elements of these claims being “nonfunctional” and the subsequent failure to consider them in assessing patentability of these claims. How “points,” “airtime,” “text messages,” and “coupons,” which are indeed structural elements, are rendered as “nonfunctional” and “descriptive” is not explained by the Examiner. In making these allegations, the Examiner cited In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) and In re Lowry, 32 USPQ.2d 1031 (Fed. Cir. 1994). However, the Examiner erred in applying these cases.

Applicant asserts that the Examiner’s citation of In re Gulack and In re Lowry are not applicable in this case. In a rejection, the Examiner may use the rationale of legal precedent established by prior case law, subject to the following considerations. “The examiner must apply the law consistently to each application after considering all the



relevant facts. *If the facts in a prior legal decision are sufficiently similar to those in an application under examination*, the examiner may use the rationale used by the court.” M.P.E.P. § 2144 (emphasis added).

Gulack addresses “printed matter” rejections. Specifically, Gulack holds that “[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.” Gulack, 217 USPQ at 404. Moreover, in Lowry, the Federal Circuit rejected a previous attempt by the Office to apply the printed matter rejection in other contexts.

The printed matter cases dealt with claims defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind. The printed matter cases have no factual relevance where the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer.

Lowry, 32 USPQ.2d at 1034 (internal quotations and citation omitted). The present claims are drawn to systems and methods, not printed lines and characters.

Accordingly, Applicant submits that the cited printed matter cases are not relevant to the patentability of Applicant’s claimed invention.

In rejecting claims 7, 12, and 18, the Examiner relies on Official Notice in stating that “[o]fficial notice is taken that account accessibility is well known.” Office Action at 5. Further, the Examiner also relies on Official Notice in rejecting claims 9 and 14, stating that “[o]fficial notice is taken that it is well known that a database may be structured in any desirable manner.” Id.

The Examiner is respectfully reminded of the provisions of MPEP Section 2144.03, and the precedents provided in Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999) and In re Ahlert, 424 F.2d, 1088, 1091, 165 USPQ 418, 420 (CCPA 1970).

An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. It is never appropriate to rely solely on "common knowledge" without evidentiary support in the record as the principal evidence upon which a rejection is based. Accordingly, Applicant traverses the Official Notice and requests that the Examiner either cite a competent prior art reference in substantiation of these conclusions, or else withdraw the rejections.

**B. The Rejection of Claims 6, 15, and 20.**

Claims 6, 15, and 20 depend upon claims 1, 11, and 17, respectively. As explained above, claims 1, 11, and 17 are patentable over Angles et al. in that Angles et al. does not teach at least "registering a wireless device," "receiving registration information including at least a wireless device number," or "a database comprising wireless device numbers." Furthermore, Angles et al. does not suggest at least "registering a wireless device," "receiving registration information including at least a wireless device number," or "a database comprising wireless device numbers." Accordingly, claims 6, 15, and 20 are patentable over Angles et al. because the reference fails to teach or suggest at least "registering a wireless device," "receiving registration information including at least a wireless device number," or "a database comprising wireless device numbers," as recited in independent claims 1, 11, and 17.

Moreover, Bezos et al. does not make up for the deficiencies of Angles et al. regarding these claims. That is, Bezos et al. does not teach or suggest at least

“registering a wireless device,” “receiving registration information including at least a wireless device number,” or “a database comprising wireless device numbers.”

Furthermore, the Examiner stated that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Angles et al. to include that users receive remuneration for referring an unregistered user to receive advertising messages, because it would allow advertisers to expose their products to [a] larger audience, [and] thereby increase revenue.” Office Action at 6-7. This statement, however, is insufficient to establish a *prima facie* case of obviousness. First, it is established that “[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references.” M.P.E.P. § 2143.01, at 2100-125 (citing Al-Site Corp. v. VSI Int’l Inc., 174 F.3d 1308 (Fed. Cir. 1999)). Further, the motivation to combine alleged by the Examiner is unrelated to the asserted claims. Claims 6, 15, and 20 are not directed to increasing revenue. Finally, the Examiner’s allegation that it would have been obvious to modify Angles et al. to provide remuneration for referring other customers because doing so would increase revenue is unsupported by any factually-based evidence made of record. Not only is the Examiner’s conclusion of questionable relevance to the subject matter being claimed, but, further, the Examiner has provided no evidence that providing remuneration for referrals actually increases revenue.

Moreover, “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” Id. § 2143.01, at 2100-126 (quoting In re Mills, 916 F.2d 680, 682 (Fed. Cir. 1992)) (emphasis added). There is no such suggestion in Angles et al.

For at least the foregoing reasons, claims 6, 15, and 20 are patentable over Angles et al. and Bezos et al. Applicant therefore requests that the rejection of claims 6, 15, and 20 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

#### IV. Conclusion


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:  Reg 24,014  
for Richard V. Burgujian  
Reg. No. 31,744